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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,213	09/22/2000	Ynjiun P. Wang	ESX/005	9838
26290 7590 11/12/2008 PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD SUITE 1500 HOUSTON, TX 77056				
EXAMINER				
SHERR, CRISTINA O				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
11/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/668,213

**Applicant(s)**

WANG ET AL.

**Examiner**

CRISTINA OWEN SHERR

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-11, 13-16 and 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-11, 13-16, and 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to Applicant's amendment filed July 28, 2008. Claims 1, 2, 3, 4, 7, 13, and 18 are currently amended. Claims 1-4, 7-11, 13-16, and 18-28 are currently pending in this case.

#### ***Response to Arguments***

2. Applicant's arguments with respect to the section 112 rejection of the claims, given their current amended form, are persuasive. The section 112 rejection is hereby withdrawn.

Applicant's arguments with respect to the section 103 rejections of claims 1, 7, 13, and 18, as currently amended, have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-11, 13-16, and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan et al (US 5,604,801) in view of Rothstein (Edward Rothstein (1997, January 20). Making the Internet come to you, through 'push' technology. New York Times (Late Edition (east Coast)), p. 5. Retrieved December 7, 2007, from Banking Information Source database. (Document ID: 10883254).), further in view of Benson (US 6,334,118).

5. Regarding claim 1 –

6. Dolan discloses a method for a transaction request from an remote electronic transaction system running an xAgent to a portable electronic authorization device (PEAD) carried by a user for an electronic confirmation, comprising (e.g. col 6 ln 53- col 7 ln 2) steps of:

receiving at the portable electronic authorization device first digital data representing the transaction request; (col 6 ln 53 – col 7 ln 5)

providing information to the user regarding an ability to approve or modify the transaction request performing approval and encryption of the transaction approval within the PEAD; (col 6 ln 50 – col 7 ln 24) and

when the transaction request is approved by the user, receiving at the electronic transaction system second digital data representing the electronic confirmation of the transaction request, (col 7 ln 18-24)

wherein the receiving step is performed via a wireless communication port associated with the portable electronic authorization device. (e.g. abs)

Dolan does not specifically disclose push technology as the manner in which the transaction request is sent. Rothstein, however, does (e.g. par 2-3).

Dolan further does not specifically disclose utilizing a private key stored within the PEAD without transmission of the private key to the remote electronic transaction system or entry of the private key by the user to the PEAD. Benson, however, does, at, e.g col 8 ln 17-24.

7. It would be obvious to one of ordinary skill in the art at the time the invention was made to use push technology to make transaction requests since "pushing makes" facilitates making money on the internet by guaranteeing sites more visitors and thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-7). Further, it would have been obvious to combine Benson with the above references since Benson, like Dolan is in the field of authorizing electronic transactions, and motivated by the need for greater security through the prevention of interception of private keys.

8. Regarding claims 2-4 –

Rothstein discloses pushing technology (par 3, "This is being called 'push'..."). Specifically, Rothstein teaches a user automatically receiving information (par 3) via software ("smart") agents (paragraph... "Ultimately...") that are programmed to retrieve information from the internet that meet the user's predetermined criteria. Therefore, a predictable result (see, e.g., *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396) of Rothstein would be to apply push technology to retrieving any user information (e.g. stock related, sports, auctions, etc.).

9. Regarding claim 7 –

10. Dolan discloses a portable electronic authorization device (PEAD) (e.g. abs) for approving a transaction request from a point-of-sale system (e.g. col 6 ln 57 – col 7 ln 24), comprising:

a transceiver in the portable electronic authorization device configured to receive first digital data representing the transaction request; (col 5 ln 20-45)

a display configured to provide information to the user regarding ability to approve or modify the transaction request; (e.g. fig 1, 130)

a scanner configured to scan at least one of bar-code or OCR information; (e.g. col 3 ln 50-65)and

a downloadable transaction program to enable the portable electronic authorization device to perform a transaction; (col 6 ln 57- col 7 ln 24)

wherein the transceiver is further configured such that when the transaction request is approved by the user, the transceiver is configured to transmit second digital data representing the electronic confirmation of the transaction request the means for performing the approval and encrypting the transaction approval being included within the PEAD. (col 6 ln 57- col 7 ln 24).

As above, Dolan does not specifically disclose push technology as the manner in which the transaction request is sent. Rothstein, however, does (e.g. par 2-3). Specifically, Rothstein teaches a user automatically receiving information (par 3) via software ("smart") agents (paragraph... "Ultimately...") that are programmed to retrieve information from the internet that meet the user's predetermined criteria. Therefore, a predictable result (see, e.g., *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396) of Rothstein would be to apply push technology to retrieving any user information (e.g. stock related, sports, auctions, etc.).

11. Dolan further does not specifically disclose utilizing a private key stored within the PEAD without transmission of the private key to the remote electronic transaction

system or entry of the private key by the user to the PEAD. Benson, however, does, at, e.g. col 8 ln 17-24.

12. It would be obvious to one of ordinary skill in the art at the time the invention was made to use push technology to make transaction requests since "pushing makes" facilitates making money on the internet by guaranteeing sites more visitors and thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-7). Further, it would have been obvious to combine Benson with the above references since Benson, like Dolan is in the field of authorizing electronic transactions, and motivated by the need for greater security through the prevention of interception of private keys.

13. Regarding claim 8 –

14. Dolan discloses the portable electronic authorization device of claim 7, wherein:

15. the scanner is configured to scan in barcode information to establish a communications link between the portable electronic authorization device and a Point-of-Sale terminal. (e.g. col 3 ln 50-65).

16. Regarding claim 9 –

17. Dolan discloses the portable electronic authorization device of claim 7, wherein:

18. the scanner is at least one of a barcode or an OCR scanner. (e.g. col 3 ln 50-65).

19. Regarding claim 10 –

20. Dolan discloses the portable electronic authorization device of claim 7, wherein: the transceiver is at least one of an infrared, a Bluetooth or a wireless receiver. (e.g. col 3 ln 50-65).

21. Regarding claim 11 –

22. Dolan discloses the portable electronic authorization device of claim 8, wherein: the scanner is configured to scan in barcode product information for self- checkout. (e.g. col 3 ln 50-65).

23. Regarding claim 13 –

24. Dolan discloses a method for xAgent automatic ordering from a remote merchant server using a portable electronic authorization device carried by a user, comprising the steps of:

entering product information at the portable electronic authorization device;  
accumulating the product information by an xAgent running on the portable electronic authorization device; (e.g. col 6 ln 57 – col 7 ln 24)

receiving at the portable electronic authorization device a first digital data representing the transaction request; providing information to the user regarding an ability to approve the transaction request; when the transaction request is approved by the user, (col 6 ln 53 – col 7 ln 5)

encrypting transaction approval data as second digital data representing approval by the user to purchase the item performing approval and encryption of the transaction approval within the PEAD; and

transmitting the second digital data to the electronic transaction system to approve the transaction request with the electronic transaction system.; (col 6 ln 57- col 7 ln 24).

25. As above, Dolan does not specifically disclose push technology as the manner in which the transaction request is sent. Rothstein, however, does (e.g. par 2-3).

Further, Rothstein discloses pushing transactions which are triggered by certain predetermined events. (e.g. par 4, 13, 14). Specifically, Rothstein teaches a user automatically receiving information (par 3) via software ("smart") agents (paragraph... "Ultimately...") that are programmed to retrieve information from the internet that meet the user's predetermined criteria. Therefore, a predictable result (see, e.g., *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396) of Rothstein would be to apply push technology to retrieving any user information (e.g. stock related, sports, auctions, etc.).

26. Dolan further does not specifically disclose utilizing a private key stored within the PEAD without transmission of the private key to the remote electronic transaction system or entry of the private key by the user to the PEAD. Benson, however, does, at, e.g. col 8 ln 17-24.

27. It would be obvious to one of ordinary skill in the art at the time the invention was made to use push technology to make transaction requests since "pushing makes" facilitates making money on the internet by guaranteeing sites more visitors and thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-7). Further, it would have been obvious to combine Benson with the above references since Benson, like Dolan is in the field of authorizing electronic transactions, and motivated by the need for greater security through the prevention of interception of private keys.

28. Regarding claim 14 –

29. Rothstein discloses pushing transactions which are triggered by certain predetermined events. (E.g. par 4, 13, 14).

30. Regarding claims 15 - 16 –

31. The method of claim 13, wherein the step of entering the product information includes using the keypad of the portable electronic authorization device to enter at least one of a product code, product name, manufacturing number, and quantity, and wherein:

the step of entering the product information includes using a scanner in the portable electronic authorization device to scan at least one of a product code, product name, manufacturing number, and quantity. (e.g. col 3 ln 50-65).

32. Regarding claim 18 –

33. Dolan discloses a method for self-checkout between an electronic point of sale transaction system and a portable electronic authorization device (PEAD) carried by a user, comprising the steps of:

entering product information at the portable electronic authorization device (e.g. col 4 ln 32-57);

establishing communication link between the electronic point of sale transaction terminal and the portable electronic authorization device; (e.g. col 5 ln 20-40)

receiving at the portable electronic authorization device a first digital data representing the transaction request; providing information to the user regarding an ability to approve the transaction request; when the transaction request is approved by the user,

encrypting transaction approval data as second digital data representing approval by the user to purchase the item (e.g. col 6 ln 54- col 7 ln 5); and transmitting the second digital data to the electronic transaction system to approve the transaction request with the electronic transaction system performing approval and encryption of the transaction approval within the PEAD; and printing a receipt at a remote printer. (e.g. col 6 ln 57- col 7 ln 24)

34. As above, Dolan does not specifically disclose push technology as the manner in which the transaction request is sent. Rothstein, however, does (e.g. par 2-3). Further, Rothstein discloses pushing transactions which are triggered by certain predetermined events. (e.g. par 4, 13, 14).

Dolan further does not specifically disclose utilizing a private key stored within the PEAD without transmission of the private key to the remote electronic transaction system or entry of the private key by the user to the PEAD. Benson, however, does, at, e.g. col 8 ln 17-24.

35. It would be obvious to one of ordinary skill in the art at the time the invention was made to use push technology to make transaction requests since "pushing makes" facilitates making money on the internet by guaranteeing sites more visitors and thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-7). Further, it would have been obvious to combine Benson with the above references since Benson, like Dolan is in the field of authorizing electronic transactions, and motivated by the need for greater security through the prevention of interception of private keys.

36. Regarding claim 19 –

37. Dolan discloses the method of claim 18, wherein: the step of encrypting the approval data is performed using a public key cryptography technique using at least a user's private key. (e.g. col 3 ln 1-20)

38. Regarding claim 20 –

39. Dolan discloses the method of claim 18, wherein: the step of entering the product information includes using a keypad of the portable electronic authorization device to enter at least one of a product code, product name, manufacturing number, and quantity. (col 2 ln 65 – col 3 ln 10).

40. Regarding claim 21 –

41. Dolan discloses the method of claim 18, wherein: the step of entering the product information includes using a scanner of the portable electronic authorization device to scan at least one of a product code, product name, manufacturing number, and quantity. (col 2 ln 65 – col 3 ln 10).

42. Regarding claim 22 –

43. Dolan discloses the method of claim 18, wherein: the step of printing the receipt step includes establishing a connection between the portable electronic authorization device and the printer. (e.g. fig 1, col 5 ln 22-37).

44. Regarding claim 23 –

45. Dolan discloses the method of claim 22, wherein: the step of establishing a connection between the portable electronic authorization device and the printer is

performed by entering printer identification information into the portable electronic authorization device. . (e.g. fig 1, col 5 ln 22-37).

46. Regarding claim 24 –

47. Dolan discloses the method of claim 22, wherein: the step of establishing a connection between the portable electronic authorization device and the printer is performed by entering subscriber identification information into the printer. (col 3 ln 38-60).

48. Regarding claims 25-26 –

49. Dolan discloses the method of claim 22, wherein: the step of establishing a connection between the portable electronic authorization device and the printer is via infrared. or short range (e.g. col (col 5 ln 20-45).

50. Regarding claim 27 –

51. Dolan discloses the method of claim 1, wherein the approval is carried out based on user identification data saved entirely within the PEAD. (e.g. col (col 6 ln 24-35)

52. Regarding claim 28 -

53. Dolan discloses the method of claim 1 wherein the encryption is conducted utilizing the user's private key. (e.g. col 4 ln 60-67).

54. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

55. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

56. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

57. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

58. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

59. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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